

REMARKS

The Office Action dated August 17, 2009, has been carefully reviewed and the following comments are made in response thereto. In view of the amendments and the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Without prejudice or disclaimer and for the sole purpose of advancing prosecution, Applicants have cancelled claims 1 to 4, 11 to 13. Applicants have amended claim 5, 8 to 10, and 14 to 16. Claim 5 was amended to incorporate the features of claim 1. The other claims were merely amended to change the dependency. New claim 17 merely recites the subject matter of previous claim 2 and depends on claim 5. In addition, Applicants have amended the abstract and amended the specification to correct a typographical error. No new matter has been added.

The Objection to the Abstract should be withdrawn

The Office Action objected to the Abstract for allegedly being in excess of 150 words. To advance prosecution, Applicants have amended the abstract to be less than 150 words long. Accordingly, this objection is moot.

The Rejections under 35 U.S.C. 101 should be withdrawn

Claims 1 to 4 and 8 to 16 were rejected under 35 U.S.C. 101 for allegedly being directed to non-statutory subject matter. Without acquiescing to the merits of the rejection and for the sole purpose of advancing prosecution, Applicants have canceled 1 to 4, 11 to 13 and amended claims 8 to 10 and 14 to 16 to depend on claim 5. Since claim 5 is directed to statutory subject matter, the claims as amended are also directed to statutory subject matter. Accordingly, Applicants request withdrawal of this rejection.

The Rejections under 35 U.S.C. 102(e) should be withdrawn

Claims 1 to 7, 9 to 12, and 14 were rejected under 102(e) for allegedly being anticipated by Eils (U.S. Pub. App. 2004/0076984 A1). Applicants respectfully disagree.

Without prejudice or disclaimer and for the sole purpose of advancing prosecution, Applicants have canceled 1 to 4 and 11 to 13, accordingly the rejection of these claims is moot. The remaining pending claims directly or indirectly depend on claim 5 which, as amended, is directed to a disease prognosis prediction device.

As the Examiner is aware, for a reference to anticipate, the reference has to disclose or suggest each and every feature of the pending claims. Eils fails to disclose or suggest each of the features of claim 5, as amended, and accordingly the reference cannot anticipate. In particular, Eils fails to disclose the determination of a priority of clinical test items for the prognosis of a disease where there are a plurality of test items as required by claim 5. Eils also fails to disclose the establishment of a judgment routine in which correlation of the plurality of clinical laboratory test items and the clinical laboratory test value ranges of the test items with the predicted value of the prognosis is stipulated on the basis of the priority as required by claim 5. Since Eils does disclose or suggest all the elements of claim 5, the reference also fails to disclose or suggest the elements of the remaining claims. Accordingly, Eils does not anticipate the pending claims.

In view of the foregoing amendments and arguments, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 102(e).

The Rejections under 35 U.S.C. 103(a) should be withdrawn

Claims 8, 13, 15 and 16 were rejected under 35 U.S.C. 103(a) for being allegedly obvious over Eils in view of Watanabe *et al.* (U.S. Patent No. 5,516,640). Applicants respectfully disagree.

Prior to discussing the merits of the rejection, Applicants note that without prejudice or disclaimer and for the sole purpose of advancing prosecution, Applicants have canceled 1 to 4 and 11 to 13, accordingly the rejection of claim 13 is moot. Furthermore, Applicants have amended claims 8, 15 and 16 to depend on claim 5.

The combination of Eils and Watanabe *et al.* does not disclose or suggest each element of the pending claims and accordingly, these references cannot render the pending claims obvious. In particular, as discussed above, Eils fails to disclose or suggest (a) the determination of a priority of clinical test items for the prognosis of a disease where there are a plurality of test items and (b) the establishment of a judgment routine in which correlation of the plurality of clinical laboratory test items and the clinical laboratory test value ranges of the test items with the predicted value of the prognosis is stipulated on the basis of the priority. Watanabe *et al.* fails to fill any gaps in the disclosure of Eils. Accordingly, the combination of these references does not disclose or suggest each and every element of claim 5. Since claims 8, 15 and 16 depend on claim 5, the combination of the references also does not disclose or suggest each and every element of the claims. According, the combination of Eils and Watanabe *et al.* cannot render the pending claims obvious.

In view of the foregoing amendments and arguments, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. 103(a).

Conclusion

It is respectfully submitted that all claims are now in condition for allowance, early notice of which would be appreciated. Should the Examiner disagree, Applicants respectfully request a telephonic or in-person interview with the undersigned attorney to discuss any remaining issues and to expedite the eventual allowance of the claims.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: **November 12, 2009**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Ave., N.W.
Washington, D.C. 20004
202-739-3000

Respectfully submitted
Morgan, Lewis & Bockius LLP

/Robert Smyth/
Robert Smyth
Registration No. 50,801